

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed July 30, 2004. At the time of the Office Action Claims 1-33 of the present application were pending. Claims 1-33 were rejected by the Final Office Action. In order to advance prosecution of this case, Applicants amend Claims 1, 8-12, 14, 20-21, 27-28, and 33. Applicants respectfully request reconsideration and favorable action in this case.

Interview Summary

Applicants thank the Examiner for the telephone interview of September 23, 2004. During the interview, Applicants pointed out that in response to the first Office Action Claim 11 had been rewritten in independent form, but was otherwise unamended. Applicants expressed their view that the finality of this Office Action was improper as the Examiner had changed the grounds of rejection when an unamended claim was present. The Examiner agreed with the Applicants view and agreed to make the rejection non-final after the Examiner had the opportunity to review the case and verify the unamended status of Claim 11.

Section 103 Rejections

The Office Action rejects Claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,453,022 issued to Weinman, Jr. ("*Weinman*"). Applicants respectfully traverse these rejections for the reasons stated below.

In order to establish a *prima facie* case of obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Claim 1 is directed to a method for managing incoming and outgoing calls when an endpoint has been placed on hold. The method includes establishing a first call on a packet switched network over a first phone line of a first endpoint. The first call is between the first endpoint and a second endpoint, and includes an outbound media stream communicated from the first endpoint. The method also includes detecting that the first call was placed on hold by the second endpoint and establishing a second call on the packet switched network over a second phone line of the first endpoint. The second call is between the first endpoint and a

third endpoint. The outbound media stream is communicated in the second call, and a first incoming media stream from the first call is mixed with a second incoming media stream from the second call for presentation to a user of the first endpoint.

Weinman does not disclose, teach, or suggest each of the elements of Claim 1. Specifically, *Weinman* does not disclose, teach, or suggest a packet switched network, establishing a first call on the packet switched network over a first phone line of a first endpoint, or establishing a second call on the packet switched network over a second phone line of the first endpoint. Instead, *Weinman* discloses a multi-line telephone system 105 coupled to a central office 120 of a standard public telephony network 125. See *Weinman*, column 3, lines 29-31; figure 1. For at least these reasons, Applicants respectfully submit that the cited portions of *Weinman* do not disclose, teach, or suggest each element of Claim 1 and request that the rejection of Claim 1 be withdrawn.

Each of Claims 11, 14, 28, and 33 include limitations related to establishing first and second calls on a packet switched network. The portions of the *Weinman* reference relied upon by the Office Action do not disclose each of these limitations, for example, for similar reasons as those discussed above with regard to Claim 1. Therefore, Claims 11, 14, 28, and 33 are believed to be patentably distinguishable from the cited portions of the *Weinman* reference.

Claims 2-10 and 13 depend from, and incorporate all the limitations of, independent Claim 1. Claims 15-20 depend from, and incorporate all the limitations of, independent Claim 14. Claims 29-32 depend from, and incorporate all the limitations of, independent Claim 28. Therefore, Applicants respectfully submit that Claims 2-10, 13, 15-20, and 29-32 are patentably distinguishable from the cited art, for example, for the same reasons discussed above with regard to Claims 1, 14, and 28.

Additionally, Claims 8 and 9 further define the invention of independent Claim 1, and recite subject matter not disclosed by the *Weinman* reference. For example, Claim 8 includes a signal communicated from the second endpoint to a call manager via the packet based network, and Claim 9 includes a call manager communicating media streams to a call resource and to the first endpoint. The cited portions of the *Weinman* reference do not disclose a signal communicated to a call manager, or the call manager communicating media streams. Instead, *Weinman* contemplates a multi-line telephone, coupled to a central office

120 of a standard public telephony network, with one or more audio controllers that allow the user to selectively adjust one or more characteristics of the audio signal received and transmitted by the multi-line telephone. *See Weinman*, column 3, lines 29-31, 47-51; figure 1. For at least these additional reasons, Applicants respectfully submit that Claims 8 and 9 are patentably distinguishable from *Weinman*.

Claim 12 has been rewritten in independent form but is otherwise unamended. Claim 12 is directed to a method for managing incoming and outgoing calls when an endpoint has been placed on hold. The method includes establishing a first call on a network over a first phone line of a first endpoint. The first call is between the first endpoint and a second endpoint, and includes an outbound media stream communicated from the first endpoint. The method also includes detecting that the first call was placed on hold by the second endpoint and establishing a second call on the network over a second phone line of the first endpoint. The second call is between the first endpoint and a third endpoint. The outbound media stream is communicated in the second call, and a first incoming media stream from the first call is mixed with a second incoming media stream from the second call for presentation to a user of the first endpoint. Establishing the first call on the network between the first endpoint and the second endpoint includes receiving signaling information at the first and second endpoints from a call manager coupled to the network. Detecting that the first call was placed on hold by the second endpoint includes receiving a signal communicated from the second endpoint to the call manager via the network indicating that the first call was placed on hold.

Weinman does not disclose, teach, or suggest each of the elements of Claim 12. Specifically, *Weinman* does not disclose, teach, or suggest a call manager, receiving signaling information at the first and second endpoints from a call manager, or receiving a signal communicated from the second endpoint to the call manager via the network indicating that the first call was placed on hold. Instead, *Weinman* contemplates a multi-line telephone, coupled to a central office 120 of a standard public telephony network, with one or more audio controllers that allow the user to selectively adjust one or more characteristics of the audio signal received and transmitted by the multi-line telephone. *See Weinman*, column 3, lines 29-31, 47-51; figure 1. For at least these reasons, Applicants respectfully submit that

the cited portions of *Weinman* do not disclose, teach, or suggest each element of Claim 12 and request that the rejection of Claim 12 be withdrawn.

Claim 21 is directed to telephony device including a network interface operable to couple to a packet switched network, a transmit circuit coupled to the network interface, and a receive circuit coupled to the network interface. The telephone device also includes a control circuit coupled to the transmit and receive circuits. The control circuit is operable to detect that a first call, over a first phone line of the telephony device, was placed on hold by a first remote endpoint. The first call includes an outbound media stream communicated to the first remote endpoint and a first incoming media stream communicated from the first remote endpoint. The control circuit is also operable to establish a second call, over a second phone line of the telephony device, on the packet switched network with a second remote endpoint after detecting that the first call was placed on hold by the first remote endpoint. The second call includes a second incoming media stream communicated from the second remote endpoint. The control circuit is further operable to instruct the transmit circuit to communicate the outbound media stream to the second remote endpoint in the second call, and mix the first and second incoming media streams for presentation to a user.

Weinman does not disclose, teach, or suggest each of the elements of Claim 21. As discussed above with regard to Claim 1, *Weinman* does not disclose, teach, or suggest a packet switched network or establishing a second call on the packet switched network over a second phone line of the first endpoint. Additionally, *Weinman* does not disclose, teach, or suggest a network interface operable to couple to a packet switched network. Instead, *Weinman* discloses a multi-line telephone system 105 coupled to a central office 120 of a standard public telephony network 125. See *Weinman*, column 3, lines 29-31; figure 1. For at least these reasons, Applicants respectfully submit that the cited portions of *Weinman* do not disclose, teach, or suggest each element of Claim 21 and request that the rejection of Claim 21 be withdrawn.

Claims 22-27 depend from, and incorporate all the limitations of, independent Claim 21. Therefore, Applicants respectfully submit that Claims 22-27 are patentably distinguishable from the cited art, for example, for the same reasons discussed above with regard to Claim 21.

Additionally, Claim 26 further defines the invention of independent Claim 1, and recites subject matter not disclosed by the *Weinman* reference. For example, Claim 26 includes a control unit receiving a signal from a call manager indicating that the first call was placed on hold. The cited portions of the *Weinman* reference do not disclose a call manager, or receiving a signal from a call manager indicating that the first call was placed on hold. Instead, *Weinman* contemplates a multi-line telephone, coupled to a central office 120 of a standard public telephony network, with one or more audio controllers that allow the user to selectively adjust one or more characteristics of the audio signal received and transmitted by the multi-line telephone. See *Weinman*, column 3, lines 29-31, 47-51; figure 1. For at least these additional reasons, Applicants respectfully submit that Claim 26 is patentably distinguishable from *Weinman*.

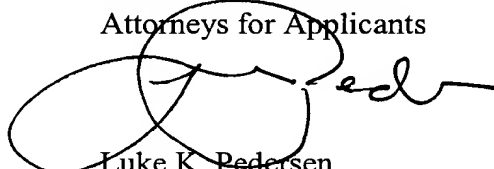
Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

A check in the amount of \$86.00 is attached to cover the fee for an additional independent claim. No other fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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